

Notice of Allowability

Application No.

10/795,880

Examiner

DAVID COMSTOCK

Applicant(s)

HAID ET AL.

Art Unit

3733

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to interview on 07 May 2010.
2. ☒ The allowed claim(s) is/are 1,2,9,10,12-19,23-28,30-37 and 55-58.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20100507.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

/David Comstock/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Douglas Collier on 07 May 2010.

The application has been amended as follows:

Claims 11, 20, 21, 29, 38 and 39 have been canceled.

Claim 1, last line, after "structure", --, wherein said inner member is movable in said outer member so that in said expanded engagement configuration a leading end and an opposite trailing end of said outer member are each expanded to engage bony tissue along the insertion pathway-- has been inserted.

Claim 9, line 1, after "said", --leading end of said-- has been inserted.

Claim 9, line 2, "includes a" has been changed to --is--.

Claim 9, line 2, after "tapered", "leading end" has been deleted.

Claim 9, lines 2-3, after "pathway", ", an opposite trailing end," has been deleted.

Claim 9, line 3, after "and", --said elongated outer member includes -- has been inserted.

Claim 9, lines 3-4, after "extending", --between said leading end and said trailing end thereof.-- has been inserted.

Claim 9, line 4, "therebetween." has been deleted.

Claim 10, line 4, "at least one " has been changed to --each --.

Claim 25, last line, after "device", --, wherein when said inner member is in said second position a leading end and an opposite trailing end of said outer member are each expanded to engage bony tissue along the insertion pathway.-- has been inserted.

Claim 27, line 1, after "said", --leading end of said-- has been inserted.

Claim 27, line 2, after "member", "includes a " has been replaced with --is --.

Claim 27, lines 2-3, "leading insertion end, an opposite trailing end, and " has been changed to --and said outer member includes --.

Claim 27, line 3, after "extending", --between said leading end and said trailing end-- has been inserted.

Claim 27, line 4, "therebetween" has been deleted.

Claim 28, line 3, "at least one of " has been changed to --each --.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The following is an examiner's statement of reasons for allowance. The arguments presented in the Pre-Appeal Brief Request for Review filed 03 February 2010 overcame the outstanding grounds of rejection for the reasons advanced therein by Applicant; however prosecution was reopened for further consideration. In an interview on 07 May 2010, Examiner discussed with Applicant a rejection that could be made over Fischer et al. (3,760,802; of record). Applicant agreed to amend the claims

as set forth above, in order to preclude the rejection. The amendment incorporates the subject matter of claims 11 and 29 into independent claims 1 and 25, respectively.

Neither Fischer et al. nor other known prior disclose each of the claim limitations including each of the ends expanding in the manner and via the structure now claimed. Fischer et al. has the expanding structure at the leading end but not at the trailing end. The dependent claims set forth above were canceled or amended to provide appropriate antecedent basis and to avoid redundant language.

Claim 1 is allowable, and the restriction requirement as set forth in the Office action mailed on 10 October 2006 has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Accordingly, claims 23 and 24 are no longer withdrawn from consideration because the claims require all the limitations of an allowable claim. Thus, claims 23 and 24 have been rejoined and examined. In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733